

REMARKS

1. The Office Action has rejected the drawing corrections on the basis that the substitute sheets of drawings introduce new matter. This rejection is respectfully traversed.

For the reasons given below with respect to the rejection of the proposed amendments to the specification, Applicant respectfully submits that no new matter has been introduced into the application by these drawing corrections. The labeling and identification of structural parts that are already present in the originally filed drawings does not constitute the introduction of new matter. Applicants respectfully submit that no new structure has been added to the drawings. Furthermore, as is reflected in the attached Declaration Under 37 C.F.R. 1.132, the changes to the specification and drawings are within the teachings of the originally submitted papers and within the teachings of the corresponding provisional patent application.

Applicants respectfully submit that changes are needed to place the drawings into conformity with the specification as amended. To that end, Applicants are submitting herewith marked up drawing corrections (with the changes from the originally submitted drawings being marked in red). Applicants are also submitting a clean copy of the corrected drawings and will submit formal drawings upon approval of these changes.

Applicants respectfully request that the drawing corrections submitted herewith be approved.

2. The Office Action has objected to amendments to the specification because of the manner in which the substitute specification was submitted and because of the entry of specified new matter into the specification. In response

thereto, Applicants are submitting herewith a marked-up copy of the specification showing the changes that are made, as well as a clean copy of the revised specification.

With respect to the identification of new matter by the aforementioned amendments to the specification, Applicants will respond to each specific issue identified in the Office Action as constituting new matter. Applicants are submitting herewith a Declaration Under 37 C.F.R. 1.132 by an engineer who is skilled in the art. This engineer clearly identifies that the disclosure of the original drawings and specification, as well as the disclosure of the original provisional patent application for which the instant patent application claims domestic priority, teach one of ordinary skill in the art the features and aspects of the invention amplified in the amendments to the specification. Accordingly, each aspect of new matter identified in the Office Action is discussed below:

A. Multiple segments that form each of the collapsible side rails 26 (original reference number), identified in the amendments to the specification as collapsible rails 26, 27, 29 and 31.

This amendment is reflected in Paragraphs 17 and 19 of the specification and in reference number changes to the drawings. Clearly the original drawings filed in this patent application reflect that the collapsible rails 26 are formed of individual segments, which can be seen in the original Figs. 1 - 4, in that the front and rear rails are separable from the adjacent side rails.

Referring first to the depiction in Fig. 1, the collapsible rails are raised to form a basket, but in Fig. 2 the front and rear side rails are moved to alternate collapsed

positions and in Fig. 4, all the rails are moved into collapsed positions. Unless these collapsible rails were formed of multiple individual segments, the respective individual portions of the collapsible rails could not be moved into a collapsed position relative to the other rail segments. Clearly, this teaching is found within the original drawings filed in the instant patent application and, thus, do not constitute new matter.

Furthermore, Figures 9 and 12 of the provisional patent application on which the instant patent application claims domestic priority clearly shows these side rails as being composed of multiple segments. Accordingly, this amendment to the specification does not constitute new matter as the description can be identified from the original disclosure made in this patent application by one of ordinary skill in the art, as is supported in the attached Declaration Under Rule 132. Likewise, the changes to the drawings to add additional reference numbers does not constitute new matter as such reference numbers only serve to clarify the teachings of the specification and no new structure is added to the drawings. The insertion of lines in the left and right side rails to reflect the differences between the segment 27 and 29 merely places Fig. 1 in conformity with the other Figures originally presented.

The Office Action comments that portions of the rails 26 disappear when the rails are in the collapsed position and that it would appear as though the forward portion of the rails is permanently attached to the roof of the vehicle. In addition, the Office Action states that it is unclear how these segments are held to adjacent segments to form the upright position shown in Figure 1.

In response to these comments in the Office Action, Applicants would suggest that the details referred to above are not pertinent to the invention as set forth in the claims discussed below. The roof rack is not casually positioned in any of the alternative configurations taught in the instant patent application. The appropriate portions of the roof rack must be manually positioned into the desired configuration. Accordingly, trim pieces that could interconnect adjacent segments of the collapsible rails can be removed and stored until the roof rack is returned to the upright configuration. The same could be true for any other aesthetic trim pieces that provide a desirable roof rack appearance. Other retractable structure could also provide the same function. Nevertheless, the existence of and the disposition of any such trim pieces or such retractable structure have nothing to do with the configurable roof rack system disclosed and claimed in the instant application.

As for the comment that the roof rack appears to be permanently attached to the vehicle roof, Applicants would direct the Examiner's attention to the lack of teaching in the specification to support such a statement. The disclosed invention is one of a roof rack system that can be configured into at least three different orientations to provide for a variety of functions for carrying cargo, including an upright basket configuration, an inwardly collapsed configuration to form an essentially flat roof shape, and an outwardly disposed configuration in which cargo could be supported along the sides of the vehicle. Having the roof rack rails permanently attached to the roof would be contradictory to the teachings of Applicants' disclosure.

B. Collapsible rails attached by hinge bars for pivotal movement.

This amendment is reflected in Paragraphs 17 and 18 of the specification and in reference number changes to the drawings. As supported in the attached Declaration Under 37 C.F.R. 1.132, the original drawings filed in this patent application clearly reflect that the collapsible side rails 26 are pivotable to move between the raised position depicted in Fig. 1, and on the left side of the vehicle in Fig. 2, to the inwardly lowered position shown in Fig. 2 on the front right side of the vehicle. Fig. 4 clearly shows that all four of the side rail members can be lowered into the inwardly collapsed position.

The use of the term "hinge bars" is merely reflective of the pivotal movement of the side rails about the corresponding hinge bar. Although the amendments to the specification first give name and reference number to these structural components, the actual structure is clearly shown in the originally submitted drawings and no new structure was added to the disclosure by the amendments to the specification and drawings.

One of ordinary skill in the art, as is reflected in the accompanying Declaration Under Rule 132, is clearly taught in the originally submitted disclosure to pivot the collapsible side rails about the bottom rail member, which has been described in the amendments to the specification as the hinge bars. Accordingly, the corresponding amendments to the specification do not incorporate new matter as Applicants are not precluded from clarifying their disclosure by adding reference numbers and an amplified detailed description to the specification.

In addition, the provisional patent application upon which the instant application claims domestic priority clearly shows in Figure 13 the details by which the collapsible side rails are pivotally mounted for collapsible movement. As depicted in Figure 13 of the corresponding provisional patent application, a pin is demonstrated as forming a hinged (or pivoted) connection between the collapsible rail and the track elements.

Accordingly, these amendments to the specification and drawings do not incorporate new matter.

C. **Track elements hingedly affixed to the connecting members.**

This amendment is reflected in Paragraphs 17 and 18 of the specification and in reference number changes to the drawings. As reflected in the attached Declaration Under Rule 132, the original drawings filed in this patent application clearly reflect that the rear collapsible side rails 26 are pivotable to move between the raised position (depicted in Fig. 1, and on the left side of the vehicle in Fig. 2) to the outwardly lowered position (shown in Fig. 2 on the rear right side of the vehicle). Fig. 4 clearly shows that the rear side rail members can be lowered into both the inwardly collapsed position and the outwardly collapsed position.

Clearly, the right rear portion of the roof rack assembly depicted in Fig. 2 of the originally submitted drawings reflects that the roof rack portion 30 is outwardly slidable and pivotable downwardly to re-position the roof rack portion 30 in a second position along the side of the vehicle. Furthermore, the original drawings depict a representative connecting member that one of ordinary skill in the art would understand would be

operable to be slidably received within the corresponding guide rail and then to permit a pivotal movement of the roof rack portion 30 to position the roof rack into the second position along side of the vehicle. As supported in the attached Declaration Under Rule 132, it is within the skill of the art to appropriately support all of the track members in such a manner.

Furthermore, the corresponding provisional patent application upon which the instant patent application claims domestic priority, clearly teaches one of ordinary skill in the art that such a pivotal connection can be accomplished with a pin defining a hinged connection, as can be found in Figure 4 and in Figure 13.

D. Latching areas defined by recesses in the mounting elements.

This amendment is reflected in Paragraph 20 of the specification. Clearly the original drawings filed in this patent application reflect that the mounting members are provided with identified recesses 52 in which attachment devices can be connected to serve as latching areas.

In addition, the provisional patent application upon which the instant application claims domestic priority further specifies that the retention openings can also be formed in the "B" and "C" pillars of the vehicle to retain a clip or hook of a bungee cord to retain cargo.

Such latching or retainment structure is within the capability and understanding of one of ordinary skill in the art. Accordingly, the amendments to Paragraph 20 do not incorporate new matter.

With respect to the changes made to the drawings, the addition of reference numbers and the labeling or identification of previously existing structural parts of the originally disclosed configurable roof rack system is in conformity with the understanding of one of ordinary skill in the art upon a reading of the instant disclosure. For the reasons given above, Applicants respectfully request that the amendments to the specification, as reflected in the enclosed substitute specification, be approved and entered.

3. The Office Action has rejected Claims 35 - 39 under the provisions of 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one of ordinary skill in the art that the inventor, at the time the application was filed, had possession of the claimed invention. The Office Action states that these claims recite various new features that were not part of the originally filed specification and that the amendments to the specification to incorporate these features constitutes new matter. This rejection is respectfully traversed.

Applicant would direct the Examiner's attention to the attached Declaration Under 37 C.F.R. 1.132 in which one of ordinary skill in the art identifies the teachings of the disclosure of the specification and drawings as originally presented, and of the corresponding provisional patent application on which the instant application claims domestic priority. The features identified in the rejected claims fall within the scope of the teachings of Applicants' original disclosure. The amendments to the specification only serve to

clarify and amplify the teachings of the original disclosure and do not incorporate new matter.

Referring to the examples given in the Office Action, the inclusion into Claim 35 of first and second guide rails and first and second connecting members are within the knowledge and understanding of one of ordinary skill in the art upon a reading of Applicants original disclosure. The original disclosure does not limit the connection of the guide rails as only for sliding. Clearly, the rails are capable of pivotal movement, as well as of sliding movement. The recess in Claim 37 is clearly depicted in the drawings and would have been understood by one of ordinary skill in the art. The pivotal (or hinged) connection of the collapsible rails in Claims 38 and 39 are very clearly taught within the original disclosure in both the regular patent application and the corresponding provisional.

Accordingly, Applicants respectfully request that this rejection be reconsidered and withdrawn.

4. The Office Action has rejected Claims 35 - 37 under the provisions of 35 U.S.C. 102(e) as being anticipated by U. S. Patent No. 6,338,427 (Aftanas). The Office Action states that Aftanas teaches a roof rack with a collapsible storage surface that is movable between a first position on top of the vehicle and a second position behind the vehicle. This rejection is respectfully traversed.

Applicant respectfully submits that the teachings of the Aftanas reference cannot meet the specific limitations of the invention as defined in independent Claim 35. More particularly, Claim 35 defines a configurable roof rack system that permits first and second connecting members to slide along the first and second guide rails to move the storage surface

from a first position on top of the vehicle roof to a second position along a lateral side of the vehicle to serve as a mounting surface on the side of the vehicle. The teachings of Aftanas to deploy the storage surface behind the vehicle cannot meet or make obvious these claim limitations.

For the reasons given above, Applicants respectfully request that this rejection be reconsidered and withdrawn.

5. The Office Action has rejected Claims 35 - 39 under the provisions of 35 U. S. C. 103(a) as being unpatentable over Aftanas in view of Great Britain Patent Publication No. 1,043,227 (Parkins). The Office Action states that Aftanas teaches rails that form a storage surface but fails to teach that the rails are collapsible or hingedly connected. The Office Action further states that the Parkins reference teaches hingedly connected front and rear rails that allow the rails to collapse and extend upwardly. The Office action concludes that it would be obvious to provide rails on Aftanas as taught by Parkins to increase storage capacity of the roof rack. This rejection is respectfully traversed.

Applicants respectfully submit that the Parkins reference does not add anything to the Aftanas patent to meet the specific claim limitations of independent Claim 35. The invention as defined by Claims 35 and 37 - 39 (Claim 36 having been canceled from the application) is not about increasing storage capacity of the roof rack, but of being able to position the roof rack in different configurations to provide different cargo carrying capabilities. Nothing in either the Aftanas or Parkins references teaches or suggests that the roof rack can be re-configured to move laterally of the vehicle to serve as a mounting surface on the side of the vehicle. Accordingly, the

Aftanas/Parkins combination cannot meet or make obvious the invention as defined by Claims 35 and 37 - 39, whether taken singly or in combination.

For the reasons given above, Applicants respectfully requests that this rejection be reconsidered and withdrawn.

6. Applicant is submitting herewith an Associate Power of Attorney in favor of the undersigned attorney and a request to change the correspondence address to Customer No. 32,994, which is to:

Larry W. Miller, Esquire
Miller Law Group, PLLC
25 Stevens Avenue
West Lawn, PA 19609

7. Applicants are submitting herewith a one month extension of time to extend the period for responding to the October 21, 2003 Office Action until February 21, 2004. The fee for this one month extension of time has been charged to Assignee's Deposit Account No. 06-1510.

8. Applicants are also enclosing herewith a Notice of Appeal for entry in the subject patent application to toll the response period. The fee for the filing of this Notice of Appeal has been charged to Assignee's Deposit Account No. 06-1510.

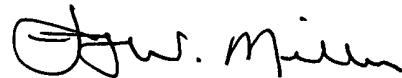
9. In summary, Claims 37 and 38 have been amended, Claim 36 has been canceled, and Claims 35 and 37 - 39 remain in the application. Applicants believe that the claims are allowable based on the foregoing amendments. Applicants respectfully

request that all objections and rejections be reconsidered and withdrawn and that all claims remaining in this case be allowed.

Pursuant to currently recommended Patent Office practice, the Examiner is expressly authorized to call the undersigned attorney if in his judgment disposition of this application could be expedited or if he considers the case ready for final disposition by other than allowance.

Respectfully submitted,

Date: February 12, 2004



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